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**NOV 20 2008**

In re Application of :  
Gegr Nathan Buchl :  
Application No. 10/774790 : **DECISION ON**  
Filing or 371(c) Date: 02/10/2004 : **PETITION**  
Attorney Docket Number: 8090 :

This is a decision in response to the petition to revive unavoidably abandoned application, filed October 2, 2008. The petition is properly treated under 37 CFR 1.137(a). Applicant requests alternate consideration of the petition under 37 CFR 1.137(b).

This Petition under 37 CFR 1.137(a) is hereby **dismissed**.

This Petition under 37 CFR 1.137(b) is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

**Background**

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed February 16, 2007. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant filed a reply on August 10, 2007; however, the reply required a three (3) month extension of time and fee in order to have been considered timely.

This Office mailed a Notice of Non-Compliant Amendment on September 19, 2007. The Notice stated that claim(s) 13 and 18 have the wrong status identifier and need to charge fee for extension for 3 months. The Notice set a one (1) month or 30 day period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant filed a reply on January 11, 2008, and included a request to "charge the fee for a three (3) month extension to Master Card 5522-[XXXX-XXXX-XXXX], Valid Dates 11/07-11/10."

No complete and proper (timely) response having been received, the application became abandoned on May 17, 2007. A Notice of Abandonment was mailed October 1, 2008.

### **The present petition**

Applicant files the present Petition and asserts that the Office apparently interpreted Applicant's authorization as an authorization for only one (1) of the two (2) extension fees then owing. Applicant asserts that Applicant's true intent for the fee authorization was to authorize payment of all fees due and owing for the two separate three-month extensions. In support of this assertion, Applicant files the Declaration of the inventor of the present application, Gregg N. Buchl. Applicant provides that after the response filed January 11, 2008, Applicant received no further correspondence from this Office that would have led Applicant to believe that fees remained due, and that because Applicant had no notice that fees remained due, the delay in submitting the required reply was unavoidable.

In the event that this Office determines that the delay was not unavoidable, Applicant requests alternative consideration of the petition under 37 CFR 1.137(b).

A review of office records reveals that no fee for a petition to revive the application under 37 CFR 1.137(b) has been submitted.

It is also noted that this Office has received one three (3) month extension of time fee only.

### **A Grantable Petition Under 37 CFR 1.137(a)**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a notice of appeal and the requisite fee; a continuing application; an amendment or request for reconsideration which *prima facie* places the application in condition for allowance, or a first or second submission under 37 CFR 1.129(a) if the application has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 USC 120, 121 and 365(c); (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Applicant lacks items (1) and (3) as set forth above.

### **Applicable Law, Rules and MPEP**

Applicant must provide a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable. In order to determine whether the delay was unavoidable, the courts have adopted a "reasonably prudent person" standard. The courts have provided that:

[t]he word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

“The critical phrase ‘unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable’ has remained unchanged since first enacted in 1861.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for “unavoidable” delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F.3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1787 (Fed. Cir. 1995) (citing In re patent No. 4,409,763, 7 U.S.P.Q.2d (BNA) 1798, 1800 (Comm’r Pat. 1990; Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which “requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.” In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)). However, “The question of whether an applicant’s delay in prosecuting an application was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account.”<sup>1</sup> Nonawareness of the content of, or a misunderstanding of, PTO statutes, PTO rules, the MPEP, or Official Gazette notices, does not constitute unavoidable delay.<sup>2</sup>

The statute requires a “showing” by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A

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<sup>1</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

<sup>2</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel’s nonawareness of PTO rules does not constitute “unavoidable” delay); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel’s actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

petition will not be granted if petitioner provides insufficient evidence to “show” that the delay was unavoidable.

35 U.S.C. 133, Time for prosecuting application, states

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.135(b) provides that

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. (Emphasis supplied).

### Analysis

As to item (1), Applicant has failed to submit the extension of time fee.

As to item (3), Applicant is reminded that the use of "shall" appears in 35 USC § 133. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991).

Here, the reply required a three (3) month extension of time and fee in order to have been considered timely. Applicant failed to provide the three (3) month extension of time fee. As such, Applicant failed to file a complete and proper reply as the condition of the application required. The application became abandoned after the six (6) month period for filing a complete and proper reply to the non-final Office action expired. The Notice of Non-Compliant Amendment incorrectly set a one (1) month period for reply. The application had, by statute, become abandoned.

Regarding Applicant's assertion that this Office apparently interpreted Applicant's authorization as an authorization for only one (1) of the two (2) extension fees then owing, and that that Applicant's true intent for the fee authorization was to authorize payment of all fees due and owing for the two separate three-month extensions, a review of the authorization reveals that Applicant intended for this Office to charge one extension of time fee. Applicant requested this Office to “charge the fee for a three (3) month extension to Master Card 5522-[XXXX-XXXX-XXXX], Valid Dates 11/07-11/10.” (Emphasis supplied). Applicant explicitly referred to the singular “a” when requesting this Office charge “a” three month extension of time fee. It is also

### Authority to act in the application

## Conclusion

## **A Grantable Petition Under 37 CFR 1.137(b)**

**(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.**

### The petition fee

Further correspondence with respect to this matter should be addressed as follows:

By FAX: (571) 273-8300  
Attn: Office of Petitions

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232. All other inquiries should be directed to the applicable Office.

/Derek L. Woods/  
Derek L. Woods  
Attorney  
Office of Petitions